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EXAMINER

GARG, YOGESH C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3625

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,934

Applicant(s)

WRIGHT, CARL A.

Examiner

Yogesh C Garg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8,10,12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) 8,10 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,10,12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment received on August 06, 2004 is acknowledged and entered. Claims 1-4, 16-18 have been amended, claims 5-7, 9, 11, 13, have been canceled and claims 8,10, and 21-23 have been withdrawn. Currently claims 1-4, 12 and 14-20 are pending for examination.

Response to Arguments

2.1. Applicant's arguments filed, see Remarks, pages 5-6 on August 6, 2004 concerning rejection of claims 1-17 under U.S.C. 101 have been fully considered and are persuasive in view of the current amendments made to independent claim 1 and therefore this rejection is withdrawn. The examiner would like to note that there was a typographical error in typing claims 1-9, 11-23 and 26-27 on page 2 of the previous office action and it should have been typed correctly as claims 1-17.

2.2. The Applicant has not traversed and provided arguments pointing out any errors in the rejection of claim 12 under 35 U.S.C. 112, first paragraph and as such this rejection is maintained.

2.3. The Applicant has amended claim 3 and therefore rejection of claims 3-4 under 35 U.S.C. 112, second paragraph withdrawn.

2.4. Applicant's arguments, see Remarks, pages 6-7 with respect to claims 1-7, 13, 16-17 and 18-20 rejected under 35 U.S.C. 102 (e) as being unpatentable over reference Ensel have been fully considered but are not persuasive for following reasons:

The applicant argues that his claims " are directed to the creation of bill content "

and Ensel has no involvement in creation of bill content (See page 6, line 5-page 7, line 2). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's invention is directed to creation of bill content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 recites collecting data pertinent to the client and to the specific fields in a bill format and producing/generating the defined bill format but does not recite creating bill content because the bill content already exists and is not created but instead it is collected and applied to the specific fields to the bill format.

The applicant argues that (a) Ensel teaches formatting bill content for different media, such as HTML or XML for web presentation (b) Ensel refers to insertion of making insert, for example , through the use of a query to review the current bills of all the customers and this loosely resembles the Applicant's software object used to query data sources to calculate bill totals or subtotals and (c) The Ensel's disclosure clearly teaches away from the actual generation of a particularized bill content. However, none of these allegations points out errors or deficiencies in the examiner's rejection of the limitations recited in the applicant's claims 1-7, 13, 16-17 and 18-20 rejected under 35 U.S.C. 102 (e) and presented on pages 6-13 of the previous office action.

The applicant's statement that the Ensel's disclosure teaches away from the actual generation or creation of bill content (see Remarks, page 7, lines 1- 10) is not relevant because (a) as analyzed above the applicant has not claimed generation of bill contents and (b) the allegation that the Ensel reference teaches away from the actual generation of a particularized bill content is relevant for obviousness type rejections under U.S.C 103 (a) in considering prior

art such that it does not teach away from the claimed invention and is not relevant to anticipation basis 102 (e) rejection. As detailed in the previous office action, see pages 6-13 the examiner has demonstrated that Ensel anticipates the limitations of claims 1-7, 13, 16-17 and 18-20. The applicant has not provided any arguments against the examiner's showing of anticipation of claim limitations.

The applicant argues that Ensel does not teach creating objects but receives these objects from external (See page 7, lines 11-13). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the applicant's invention is directed to creation of objects and that these objects are not received from an external source) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 recites extracting software objects from a library of objects and invoking them to generate bills but does not recite creating objects and that these objects are not received from an external source.

This is a Final rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim 12 contains subject matter, "selecting a language in which to produce the bill and converting all correlated data to the selected language prior to

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generating the bill ", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 16-17, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensel et al. 9US Patent 6,493,685 B1), hereinafter, referred to as Ensel.

Regarding claim 1, Ensel discloses a method for providing particularized billing services, the method comprising the steps of:

selecting a client for whom a bill is to be produced, and performing the following operations within a local, expanded , or global computing environment (see at least col.3, line 66-col.4, line 38, wherein Ensel discloses presenting bills to the consumer as per the format specified by the customer via different distribution channels, such as Internet site, Email, personal digital assistant, etc. which all satisfy to operate in a local, expanded, or global computing environment. In order to present the bill to the consumer, as per the consumer specified format, the step of selecting that consumer will be inherent. See also col.8, lines 14-

25, which discloses presenting bills to customers 80 and it would be inherent to select customers for presenting the bill as per the customer specified format);

extracting a list of software objects from a library of objects, each object being operative to generate a predefined bill format with specific fields for the selected client, invoking at least one of the software objects to collect data pertinent to the client and to the specific fields in the bill format, and producing the bill having the defined bill format, with the data collected for the selected client in the appropriate fields (see at least the following segments:

col.4, lines 17-39, " *In order to carry out the task of presenting the bills to the consumer, the IIP must have access to the "raw" billing data from the biller. This access can be accomplished either through direct access by the IIP to the accounting systems of the biller or through a data feed from the biller to the IIP. Once the billing data has been received by the IIP, the IIP formats the billing data for storage in its own internal database and then performs the task of formatting the bill for the particular channel(s) of distribution selected by the customer. Each biller has its own format and content for its "raw" billing data. Each channel of distribution has a distinct format and restrictions on content. Each customer has its own selected preference(s) for the channel on which the bill is to be presented. In light of all of these variables, the function of correctly formatting a particular bill for a particular customer is a significant task for the IIP. The present invention performs this formatting task using relational and object oriented databases which are the core of the BAP "*, and also Figs.2, 5, and

col.10, line 3-col.13, line 2, "*FIG. 2 illustrates an overview of structure of the elements of the present invention as well as the processing and data flow. Element 200 illustrates the structure of the Biller Acquisition Platform (BAP). The central feature of the design of the BAP 200 is that it is a database driven system. The BAP 200 includes a database server 202 having, for example, six database including an Enrollment file 205; a Bill Summary file 210; an E-Bill file 215 containing both current and historical data related to E-Bills; a **Template file 200 containing the templates required to format electronic bills for the various channels of distribution 310-320**; In a preferred*

embodiment of the present invention, the E-Bill file 215 is an object oriented file in which the E-Bills are stored as objects. The E-bill file 215 can be both industry specific and/or biller specific. For example, if the IIP 20 has several utility billers, a standard format for a utility bill can be derived (e.g., a graph illustrating the customer's usage). Within the standard format, each utility biller can customize the format of its own bill to be presented to its customers 80. Alternatively, each biller can custom format the entire look and feel of its bill.....", and

col.12, lines 12-18 and lines 31-42, " if the biller 5 desires to maintain electronic data for all of its customers 80, in anticipation of the customers 80 eventually signing up for electronic bill presentment. In such a case, the IIP 20 is able to immediately present an electronic bill to the previous paper customer 80. Element 245 is a reformatting processor which reformats the legacy billing data from the biller 5 in the appropriate format for inclusion on the database server 202. The billing data for the electronic bills is passed from the splitter 255 to the reformatting processor 245 ... The details of the formatting by reformatting processor 245 varies from biller to biller and is driven by the format of the billing data provided by the biller. The reformatting processor 245 feeds the Summary data file 210 and the E-Bill database 215 with the data as described above with respect to each of these databases 210, 215. "

Note: The above segments disclose that a list of software objects in the form of E-Bills are stored in an E-bill file 215 which corresponds to the claimed library of objects and that retrieving the billing data, formatting the bill format, as specified by the consumer, and presenting the bill to the consumer correspond to the claimed limitation of invoking a software object to collect data and producing the bill with the collected data in appropriate fields. As regards appropriate fields, please see col.10, line 21-col.11, line 5 which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. See also col.10, line 21-col.14, line 53).

Regarding claim 2, Ensel discloses that the method of claim 1, wherein a portion of the collected data is correlated to more than one of the specific fields in the bill format (see at least col.10, line 21-col.11, line 5, which describes an E-bill file 215 varying from biller to biller and includes fields such as, customer's name, account number, address, etc. and this information is collected by the IIP to present the bills to the customers. The information collected on customer's name, address, account number, biller's information, account balance, etc. is the collected data which is correlated to more than specific fields in the bill format. See also col.10, line 21-col.14, line 53).

Regarding claims 3-4, Ensel, does show that the collected data further comprises detailed information pertinent to a billing account of the client and segmenting the detailed information into different portions of the bill (see at least col.10, line 21-col.14, line 53. The details of the charges on a credit card plus marketing inserts correspond to the claimed detailed information pertinent to a billing account which is segmented into different portions of the bills as details about charges and marketing/advertising information).

Regarding claim 16, Ensel discloses that the method of claim 1, wherein the defined bill format further comprises a corrected bill image (see col.15, lines 24-26, " *spot check bills prior to publication; and provide full audit control over all add/change/delete activity.* " . Note: checking bills and being able to execute add, change and delete activity corresponds to generating a corrected bill image)

Regarding claim 17, Ensel discloses that the method of claim 1, wherein producing the bill further comprises one or more of the following: presenting a bill image on a display device, printing a bill, sending a bill via email, and sending a bill via facsimile (see at least col.8, lines

14-25, "regular paper mail ...e-mail ..." and col.8, lines 56-62, "Other existing channels include telephone, pagers...interactive cable television....facsimile....").

Regarding system claims 18-19, their limitations are closely parallel to the method claims 1-4, and 16-17 and are therefore analyzed and rejected on the basis of same rationale. Also see FIGS. 1-6. The IIP 20 being capable of providing a billing control application through application server 240 (see Fig.2)and instructions for a bill having a predetermined format for a client (see at least col.6, line 11-col.10, line 2) . The client usage data is in Enrollment database 205 (see FIGS 2 and 5) which includes information relevant to one or more clients and corresponds to one or more client usage data sources fro which data pertinent to the predetermined format and to the specific client are retrieved and used to produce a particularized bill format (see col.10, line 3-col.12, line 43. Also see col.16, line 60- col.17, line 40).

Regarding claim20, Ensel discloses that the system of claim 18, wherein the billing server application further comprises interactive and batch functionality facsimile (see at least col.8, lines 14-25, "regular paper mail ...e-mail ..." and col.8, lines 56-62, "Other existing channels include telephone, pagers...interactive cable television....facsimile....". Note: presenting bills via paper mail or email represent batch functionality while presenting bills via interactive cable television represent interactive functionality.).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Siemens (EP 590332 A1).

Regarding claim 12, please note that it has been rejected under first paragraph of 35 U.S.C. 112 as being not enabled. Ensel teaches particularized billing services as analyzed and discussed in claim 1 above. Ensel does not disclose the steps of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill. However, Siemens discloses (see at least the "Abstract " and "Advantage", " *An internationally applicable system is used for a communication network between different countries and each country (A) has transit nodes to allow a **conversion to be made between the source language and a neutral global language (GS)**. This can then be transmitted to a number of different countries and can be translated. The process is bidirectional. ADVANTAGE - Use of global language together with translation programs installed in each country provides reduction in processing in comparison with system in which country has to carry translation programs for all other countries, and reduces number of communication translation programs* "). In view of Siemens, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of selecting a language in which to produce the bill and converting all correlated data to the selected language prior to generating the bill because it would help the system for allowing a conversion to be made from a source language to the native language of the consumer and would provide reduction in processing in comparison with system in which country has to carry translation programs for all other countries, and reduces number of communication translation programs as explicitly suggested in Siemens.

5.2 Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Mitra et al. (US 20010014878 A1), hereinafter, referred to as Mitra.

Regarding claim 14, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a closing bill. However, in the field of same endeavor, Mitra teaches producing a closing bill (see at least page 9, paragraph 0092, "*..... The controller 202 may also indicate that a **final bill** may be issued to the canceling buyer and if the buyer makes a final payment, the controller 202 will forward the payment to the unpaid sellers. Then, the controller 202 goes to step 1019. In step 1019, the controller **202 sends a final bill** to the buyer for the shortfall and goes to step 1021. In step 1021, the controller 202 determines whether a final payment has been received from the canceling buyer.*"). Note: In Mitra, Final bill corresponds to the claimed closing bill.). In view of Mitra, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a closing bill because it would enable the system to present final bills to the consumers when they close or cancel the accounts.

5.3 Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ensel and further in view of Logan et al. (US 20010009002 A1), hereinafter, referred to as Logan.

Regarding claim 15, Ensel teaches particularized billing services as analyzed and discussed in claim 13 above. Ensel does not disclose producing a duplicate bill. However, in the field of same endeavor, Logan teaches producing a duplicate bill (see at least page 8, paragraph 0096, "*....Post production activities may include, for example, storing a copy of a bill image as generated by each BPW 506 in the database for later access by a CSR on-screen in case a customer wishes to discuss an old or newly generated bill. Thus an archive database of customer bills is maintained within the system for some period of time so that images may be called up wherein the images will match the hard copies generated and mailed by the bill renderer.*"). Note: In Mitra,

storing a copy of a bill corresponds to producing a duplicate bill.). In view of Logan, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Ensel to incorporate the feature of producing a duplicate bill copy because it would help the system for later access in case a customer wishes to discuss an old or newly generated bill as suggested in Logan. Also see page 12, paragraph 0141.

6. *Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) US Patents: 6,304,857 to Heindel et al. (see at least abstract) and 6,070,150 to Remington et al. disclose a computerized system and a method allowing biller to create bills in a bill format specified by the user.

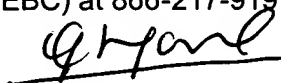
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625